

REMARKS

This Response is submitted in reply to the Office Action dated August 15, 2008. Claims 1 to 6, 8 to 11, 21 to 24, 26, 27, 31 to 33, 35, 44, 47, 49, 52, 55 and 58 have been amended. No new matter has been added by such amendments.

Applicant respectfully submits that the finality of the Office Action should be withdrawn because the Office Action did not indicate whether claim 32 is rejected or allowed as stated in the Response to Office Action of January 16, 2008. Applicant requests that the Office Action indicate the status of claim 32 in the subsequent Office Action. However, if the finality of the Office Action is not withdrawn, Applicant respectfully requests entry of the attached Request for Continued Examination. A Petition for a One-Month Extension of Time is submitted herewith. Please charge deposit account number 02-1818 for any fees due in association with this Extension of Time and this Response.

If the Request for Continued Examination is entered, Applicant requests that the Examiner provide an upcoming Office Action which will ". . . identify any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable" in accordance with §707.07(d) of the MPEP.

The Office Action rejected claims 1 to 10, 21, 23 to 26, and 31 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,931,467 to Kamille in view of U.S. Patent No. 6,217,448 to Olsen.

Kamille discloses a lottery type game including a plurality of playing spots or areas which are each initially masked in Fig. 7C. (Col. 5, lines 19 to 29.) The game starts by the player selecting one spot or area. The game includes a number of starting arrows to indicate to the player a plurality of places to begin game play. The player picks one of these starting spots. The selected spot is revealed to uncover either a directional symbol, a win symbol with an associated award, or a lose symbol. (Col. 5, lines 61 to 67.) If a directional symbol is revealed, taking the form of an arrow or pointer, the player is directed to select another specific spot or area with their next selection. The player's next selection is limited to the specific spot or area which the directional symbol indicates. A directional symbol can be a two-pronged directional

arrow that points to two locations or playing areas. If a player obtains a two-pronged direction arrow, the player must decide between the two options provided as to which play area should be selected next. (Col. 9, lines 50 to 66.) If a lose symbol is revealed, the game ends. If a win symbol is revealed, the player is provided the award associated with the win symbol and the game ends.

Olsen discloses a gaming system for providing bonus jackpot payoffs during a bonus mode among linked gaming machines. In Olsen, the gaming system creates a bonus pool from a contribution of all coins wagered at the linked gaming machines. (Column 9, lines 52 to 54). Once a bonus pool reaches a monetary value, the bonus mode starts and the gaming system selects certain eligible gaming machines for a bonus jackpot payout. The selected gaming machines continue to play the conventional game (e.g., the base game) during the bonus mode. If a selected gaming machine produces a winning outcome in the base game during the bonus mode, the gaming system determines a bonus jackpot payoff based on a conventional award multiplied by a bonus multiplier. Each sum paid over the conventional award is subtracted from the bonus pool. When the bonus pool has been depleted, the bonus mode ends. Although the bonus mode ends, bonus jackpot payouts may continue to be deducted from the bonus pool until each selected gaming machine has completed play and has been paid any bonus jackpot payout. Such continued bonus jackpot payouts may exceed the bonus pool amount. The reset value of the bonus pool for the next bonus mode is then determined based on the bonus pool amount (even if negative) at the end of the previous bonus mode. Contributions are then entered into the bonus pool beginning at the reset value of the bonus pool. When such bonus pool grows large enough, the next bonus mode is triggered. (Column 12, lines 25 to 45.)

Amended independent claim 1 is directed to a gaming device including, amongst other elements, a processor, and a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to select and display at least one of a plurality of different outcomes of a first round, select one of a plurality of different probabilities of providing a winning outcome of a second round, wherein the probability of providing the winning outcome of the second round is selected based exclusively on the number of non-selected outcomes of the first round,

determine whether to provide a player the winning outcome of the second round, wherein the determination is based on the selected probability of providing the winning outcome of the second round, and display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein the award is determined independent of any base game outcome.

Page 6 of the Office Action stated that Kamille does not disclose:

A display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein said award is determined independent of any base game award.

Page 6 of the Office Action stated that Olsen discloses:

A display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein said award is determined independent of any based game award, (col. 11:3-25).

Column 11, lines 3 to 25 of Olsen discloses:

In stage 360, the controller 30 of the present invention sends this information over network 32 to instruct the winning selected gaming machine S to pay a bonus jackpot amount in stage 360. In this example, the player sitting at the winning selected gaming machine S actually receives 30 coins, i.e., 10 coins, representing the conventional payout from play and 20 coins as determined by the controller 30. This is a separate determination and that the jackpot bonus payout of 20 coins is independent of the operation of the pay table in the underlying gaming machine. That is the present invention does not alter, reconfigure, or modify the pay table or the payout structure in the conventional gaming machine in the play of the gaming machine. Rather, the game is conventionally played, a game payoff is conventionally generated and based on that information, the controller then determines in FIG. 3, the bonus jackpot payoff to be additionally paid to the winning selected gaming machine S. The bonus payout is paid through the gaming device by a conventional payout command to that game. Because bonus payouts are only made to randomly selected gaming machines S, the present invention is not equivalent to a bonus pay table at the machine. In fact, the present invention is itself a secondary bonus game.

The Office Action concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kamille with the continuing bonus round feature of Olsen to provide a continuous bonus game to lengthen the bonus

game and increase player's enthusiasm during play and encourage further play and to increase a game player's chance at an increased outcome.

Applicant respectfully submits that Kamille and Olsen individually, and the gaming device resulting from the combination of Kamille in view of Olsen do not disclose or render obvious, amongst other elements, a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein the award is determined independent of any base game outcome. In Olsen's gaming system, a base game outcome is used to determine both conventional awards and bonus jackpot payoffs (made during a bonus mode). More specifically, column 10, lines 37-39 of Olsen discloses that:

The amount of the bonus jackpot payoff that the participating selected gaming machine S pays is dependent upon the outcome of the underlying game that is played. (emphasis added).

For example, if a gaming device resulting from the combination of Kamille and Olsen detects a winning condition during a bonus mode, the gaming device determines a conventional award based on the winning condition from the base game and further determines the bonus jackpot payoff based on the winning condition of the same base game. In other words, the gaming device resulting from the combination of Kamille and Olsen determines the bonus jackpot payoff based directly on the outcome of the base game and not independent of any base game outcome. Accordingly, Kamille and Olsen individually, and the gaming device resulting from the combination of Kamille and Olsen do not disclose or render obvious a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein the award is determined independent of any base game outcome.

Moreover, it would not have been obvious to one of ordinary skill in the art to modify Kamille and Olsen to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, amended

independent claim 1 includes a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round wherein the award is determined independent of any base game outcome.

The Response to Arguments section of the Office Action stated that:

[t]he examiner points to the fact that once the bonus award has started the reels function as a bonus game and their outcome is determined differently from the outcome of the base game. (emphasis added).

Applicant respectfully disagrees and submits that the outcome of the bonus game of Olsen is not determined differently from the outcome of the base game of Olsen because the gaming device of Olsen does not include a separate bonus game. In Olsen, the gaming device uses the outcome of a base game to determine both a conventional payout and a bonus jackpot payoff. That is, the same base game in Olsen is used to determine both the conventional payoff and the bonus jackpot payoff.

The Response to Arguments section of the Office Action also stated that:

[t]hus independent of the base game, at the very least, making the bonus award independent of the base game is only a design choice from a limited number of ways to produce a bonus award.

Applicant respectfully disagrees and submits that a gaming device including a processor programmed to operate with the display device to display an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round wherein the award is determined independent of any base game outcome is substantially more than a simple design choice. Based on the MPEP guidelines for asserting design choice, it is not appropriate for the Office Action to assert that the feature of determining an award independent of any base game outcome of the gaming device of amended independent claim 1 is a design choice because an award determined independent of any base game outcome of the gaming device of amended independent claim 1 is functionally different from a bonus jackpot payoff and a base game award having independent paytables of the gaming device resulting from Kamille in view of Olsen. Specifically, the MPEP §2144.04(l) states that a feature that is merely an aesthetic design change does not distinguish from prior art if the claimed features

relate to ornamentation and not to function (citing *In re Seid*, 161 F.2d 229 (CCPA 1947)). The MPEP §2144.04(VI)(C) also states that a rearrangement of parts may be an obvious matter of design choice where moving a feature of an invention would not have modified the operation of the device (citing *In re Japikse*, 181 F.2d 1019 (CCPA 1950)). A gaming device that includes displaying an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round wherein the award is determined independent of any base game outcome is neither an aesthetic design change or a rearrangement of parts. Accordingly, the Office Action's conclusions of obvious design choice cannot properly form the basis of this rejection. For at least these reasons, Applicant submits that amended independent claim 1 is patentably distinguished over Kamille in view of Olsen and is in condition for allowance.

Applicant submits that claims 2 to 10 depend directly or indirectly from amended independent claim 1 and are also allowable for the reasons given with respect to amended independent claim 1 and because of the additional features recited in these claims.

Amended independent claims 21, 23, and 31 each include certain elements similar to certain elements of amended independent claim 1. For reasons similar to the reasoning discussed above with respect to amended independent claim 1, amended independent claims 21, 23, and 31 (and dependent claims 23 to 26) are each patentably distinguished over Kamille in view of Olsen and are in condition for allowance.

The Office Action also rejected Claims 11 to 20, 22, 27 to 30, 33, 34, and 44 to 60 under 35 U.S.C. §103(a) as being unpatentable over Kamille in view of U.S. Patent No. 6,190,255 to Thomas et al. ("Thomas") and in further view of Olsen.

Amended independent claim 11 generally includes, amongst other elements, displaying an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein the award is determined independent of any base game outcome.

The Office Action stated that it would have been obvious to modify Kamille with Thomas and Olsen in order to provide a continuous bonus game to lengthen the bonus game and increase player's enthusiasm during play and to encourage further play and to increase a game player's chance at an increased outcome.

Applicant submits that regardless of whether or not it would have been obvious to incorporate Kamille with Thomas and Olsen, Kamille, Thomas, and Olsen individually, and the gaming device resulting from the combination of Kamille, Thomas, and Olsen do not disclose or renders obvious, amongst other elements, displaying an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein the award is determined independent of any base game outcome. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Kamille, Thomas, and Olsen to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, the gaming device of amended independent claim 11 includes, amongst other elements, displaying an award based on at least one of the selected outcomes of the first round and any winning outcome of the second round, wherein the award is determined independent of any base game outcome. For at least these reasons, Applicant submits that amended independent claim 11 is patentably distinguished over Kamille in view of Thomas and further in view of Olsen and is in condition for allowance.

Applicant submits that claims 12 to 20 depend directly or indirectly from amended independent claim 11 and are also allowable for the reasons given with respect to amended independent claim 11 and because of the additional features recited in these claims.

Amended independent claims 22, 27, 33, 44, 47, 52, and 58 each include certain elements similar to certain elements of amended independent claim 11. For reasons similar to the reasoning discussed above with respect to amended independent claim 11, amended independent claims 22, 27, 33, 44, 47, 52, and 58 (and dependent claims 28 to 30, 34, 45 to 46, 48 to 51, 53 to 57, and 59 to 60) are each patentably distinguished over Kamille in view of Thomas and further in view of Olsen and are in condition for allowance.

The Office Action rejected claim 35 under 35 U.S.C. §103(a) as being unpatentable over Kamille in view of U.S. Patent No. 6,485,367 to Joshi and in further view of Olsen.

Amended independent claim 35 generally includes, amongst other elements, a memory device which stores a plurality of instructions, which when executed by the

processor, cause the processor to display an award based on at least one of the selected outcomes of the first round and any positive outcome of the second round, wherein the award is determined independent of any base game outcome.

The Office Action stated that it would have been obvious to modify Kamille with Joshi in order to provide game players a chance at a bigger payout outcome, which will attract frequent play by enhancing the entertainment value and excitement associated with the game. The Office Action further stated that it would have been obvious to modify Kamille in view of Joshi with Olsen in order to provide a continuous bonus game to lengthen the bonus game and increase player's enthusiasm during play and encourage further play and to increase a game player's chance at an increased outcome.

Applicant submits that regardless of whether or not it would have been obvious to incorporate Kamille with Joshi and Olsen, Kamille, Joshi, and Olsen individually, and the gaming device resulting from the combination of Kamille, Joshi, and Olsen do not disclose or render obvious, amongst other elements, a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to display an award based on at least one of the selected outcomes of the first round and any positive outcome of the second round, wherein the award is determined independent of any base game outcome. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Kamille, Joshi, and Olsen to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, the gaming device of amended independent claim 35 includes, amongst other elements, a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to display an award based on at least one of the selected outcomes of the first round and any positive outcome of the second round, wherein the award is determined independent of any base game outcome. Accordingly, Applicant respectfully submits that amended independent claim 35 is patentably distinguished over Kamille in view of Joshi and further in view of Olsen and is in condition for allowance.

The Office Action rejected claims 37 to 38, 40, and 41 under 35 U.S.C. §103(a) as being unpatentable over Kamille in view of U.S. Patent No. 5,931,467 to Vancura.

As stated in the Response to Office Action dated January 16, 2008, claims 37 to 38, 40, and 41 were cancelled without prejudice or disclaimer in the Response to Office Action dated June 26, 2007. Applicant requests that this rejection be withdrawn.

An earnest endeavor has been made to place this application in condition for formal allowance and is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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